

REMARKS

Applicant would like to thank Examiner Koehler for the courtesy of granting an interview on December 3, 2004, as well as for his careful examination of the instant application. Claims 1-15 are pending in the present application. Claims 7-8, and 11-14 are objected to because of minor informalities. Claims 1-15 are rejected under 35 USC § 112, first paragraph for failing to comply with the written description requirement. Drawing sheets 1/7, 2/7, and 3/7 are objected to for improper margins under 37 CFR 1.84(g).

Interview:

Applicant presented amended claims 1-15 during the December 3, 2004 interview with Examiner Koehler. As an initial matter, the claim rejections under 35 USC § 112, first paragraph, for failing to comply with the written description requirement, were discussed. It was agreed that the rejection of claims 1-15 under 35 U.S.C. 112, 1st paragraph, should be withdrawn because the original specification incorporated the Borzillo, et al. patent (U.S. 3,343,930) in its entirety, and that the incorporated patent provides support for the invention recited in the claims, namely "between 25% and 70% aluminum by weight." It was also noted that applicant amended the specification, paragraph [00038], to include Borzillo language directed to aluminum-zinc alloy coating compositions between 25% and 70% aluminum by weight. The Examiner agreed that the amended specification more clearly supports applicant's claimed invention.

It was mentioned that applicant amended claims 7-8, and 11-14 to overcome the Examiner's formality objections, as explained in greater detail below.

Applicant also confirmed that new drawing sheets 1/7, 2/7, and 3/7 are submitted to overcome the Examiner's drawing margin rejections.

The final issue discussed during the December 3, 2004 interview was directed to a newly discovered publication that was not considered during the examination of the instant application or during the examination phase of applicant's United States Patent No's. 6,468,674 and 6,689,489 upon which this continuation application is based. The new publication is a conference article entitled "Some Applications of

Electron Spectroscopy in the Sheet Metal Industry" by Mercer, et al. (Mercer). Applicant discussed the possibility of adding new claims in the instant application to recite boride ranges outside the 2 ppm boride content taught by Mercer. Applicant's specification provides support for a boride content in an amount 0.0005% (5 ppm) or greater. After careful consideration of applicant's proposed new claims, of the Mercer teaching, and of the issued claims in US 6,468,674, it was agreed that applicant's proposed new claims would be rejected under the doctrine of obviousness-type double patenting with at least claims 7, 12, and 18 issued in U.S. Patent No. 6,468,674. It was agreed that applicant should consider presenting new method claims and new article claims, having the 5ppm or greater boron content limitation, in a Continuation application rather than in the instant application.

Regarding the Mercer teaching, Examiner Koehler stated, during the interview, that he believes that the brief discussion of Al-Zn coating "grain size" in section 2.3 (page 135) does not constitute prior art that can be cited against the patent claims in applicant's U.S. Patent No. 6,468,674. The Examiner believes that Mercer does not establish a working knowledge about the intentional usage of boride constituents in an Al-Zn coating bath, and the article does not show or reasonably suggest any benefits of using boride constituents.

Claim Formality Objections

Claims, 7-8, and 11-13 are amended to correct claim number dependency. Applicant believes amended claims 7-8, and 11-13 overcomes the Examiner's objections.

Claim 14 is amended to change the words "coated steel product 2" to read -- coated steel product--. Applicant believes amended claim 14 overcomes the Examiner's objection.

Claim 4 is amended to change the words "particulate compound2" to read -- particulate compound--. Amended claim 4 more clearly recites what applicant believes is his invention.

In consideration of the above amendments and remarks, and the agreement reached during applicant's December 3, 2004 interview with Examiner Koehler,

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applicant respectfully requests examination of this application and prompt allowance of claims 1-15 into issue.

The above constitutes a complete response to all issues raised in the Official Action. Applicant believes that no new matter has been inserted into the present application by way of applicant's amendments to the claims. If the Examiner finds that this response fails to overcome the outstanding issues, or if he believes the response opens new issues, the applicant respectfully asks Examiner Koehler to telephone the number listed below to discuss any remaining issues before the Examiner mails a further communication in this matter.

A petition for a two month extension of time under 37 CFR § 1.136(a), and authorization for the Assistant Commissioner for Patents to charge the required \$450 petition fee to Deposit Account No. 02-2225, is enclosed with this response. It is believed that no additional fees are due in connection with the filing of this response. However, if any additional fees are found due, the Assistant Commissioner for Patents is hereby authorized to charge such additional fees, or to credit any overpayment of fees, to Deposit Account No. 02-2225.

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Respectfully Submitted,



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DRAWING AMENDMENTS

Drawing sheets, 1/7, 2/7, and 3/7 are enclosed with this response. The drawings are labeled "Replacement Drawing Sheets" in compliance with 37 CFR 1.84(c).